

REMARKS

This is a second amendment after final action filed in response to the final Office Action mailed on April 26, 2011 and the advisory action mailed on July 1, 2011. The claim changes proposed in the first amendment after final action were not entered according to the advisory action. Thus claim changes with respect to the pending claims in the response of February 10, 2011 are proposed. The only claim changes that are proposed are claim changes to overcome the rejection for failing to comply with the written description requirement under 35 U.S.C. § 112, first paragraph. Thus these claim changes should be entered under 37 C.F.R. § 1.116, because they put the claims in a better form for appeal if necessary (see 37 C.F.R. § 1.116 (b) (1) & (2)) and are believed to overcome the rejection under 35 U.S.C. § 112, first paragraph. Furthermore since the pending claims are free of the prior art, they should put the claims in a condition for allowance.

The present application is the U.S. National Stage of the European Patent Application, PCT/EP 2005/001442. Accordingly restriction and election issues should be handled in accordance with

the so-called “unity of invention” practice according to PCT Rule 13.1 and 13.2.

I. Rejections Based on Prior Art

The final Office Action has expressly withdrawn all previous rejections based on the disclosures in the prior art. Accordingly the amended claims are considered to be free of the prior art.

II. Rejection for Failing to Comply with the Written Description Requirement

Claims 33 to 36, 38, and 41 to 51 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Claim 42

Some of the amount ranges for the auxiliary ingredients in the claim 42 presented in the amendment of February 10, 2011 indeed were not adequately supported by the written description on page 7 of the applicants' originally filed specification. It is respectfully submitted that the above proposed changes in claim 42 have

provided a wording for claim 42 that is nevertheless fully supported by the disclosure in applicants' originally filed specification.

However the second full paragraph on page 7 of the applicants' originally filed specification that first lists the acceptable auxiliary agents did indeed omit "opacifiers" and "perfume oils", which were subsequently recited in the third full paragraph on page 7 of the applicants' specification. This imperfection in the written description has been corrected by the above change in the second full paragraph on page 7 by the insertion of the "opacifiers" and "perfume oils" in the second full paragraph on page 7. It is respectfully submitted that this change is not "new matter" for the reasons presented in the next paragraphs of these REMARKS.

The third full paragraph on page 7 of the applicants' originally filed specification begins "The **aforesaid constituents** are used in amounts usually employed for such purposes, for example..." and includes the wording now present in claim 42 that specifies the amounts of opacifiers, perfume oils, preservatives and dyes that was objected to as being "new matter" ("preservatives" and "dyes" were recited in the originally filed second paragraph). One skilled in the cosmetic arts would clearly understand that the "aforesaid constituents" is an **explicit reference** to the auxiliary agents recited

in the second full paragraph on page 7, not e.g. the active ingredients. Thus if an ingredient were to be recited in the third full paragraph on page 7, but not in the second full paragraph on page 7, one skilled in the art would understand that that omission was **an obvious error** in the second full paragraph on page 7.

Claim changes that were not considered “new matter” have been previously supported by disclosure that was considered inherent or implied, not even explicit, in the originally filed specification. For example, see *Ex Parte Brodbeck*, 199 U.S.P.Q. 230 (Bd. App. of the USPTO, 1977), in which a limitation described in terms of the number of catalyst pores was changed to a limitation described in terms of catalyst pore volume. When the CCPA reviewed *Ex Parte Brodbeck* they said:

“A change in wording to correct an error is not new matter if one skilled in the art would appreciate not only the existence of the error but what the error is.”

However in the case of the present application and the disclosure regarding the presence of “opacifiers” and “perfume oils” as auxiliary agents it is unnecessary to argue that the description on page 7 *implicitly* or *inherently* teaches that they are auxiliary agents, because of the explicit reference to the auxiliary agents in the first line of the third full paragraph on page 7. On the other hand, if one

disagrees with the opinion that “aforesaid constituents” is an explicit reference to the “auxiliary agents”, the change could still be based on the theory that the omission in the second paragraph on page 7 is an obvious error, since it is clear that all the ingredients recited in the third paragraph are at least proposed as optional ingredients of the composition used in the method and therefore could easily be categorized as “auxiliary agents”.

In addition, according to page 7, 3rd **full** paragraph, the specification states that the amount range of 0.01 to 5 wt. % applies to **each** of the opacifiers, perfume oils, dyes and preservatives in the auxiliary ingredients. Claim 42 has been amended accordingly by insertion of the word “each” in the paragraph reciting the amounts of these auxiliary ingredients.

Page 7, second **full** paragraph, of the specification discloses that the auxiliary agents can include hair-care agents. It also discloses examples of hair-care agents. Page 7, third full paragraph, states that hair-care constituents may be included in the auxiliary agents and that they can be contained in the composition in an amount of 0.1 to 5 wt. % **each**.

Page 4 of the advisory action indicates that there is no support in the specification for the lanolin derivatives, which are lanolin alkoxylates. Applicants respectfully disagree with this finding, because lanolin alkoxylates, like lanolin alcohols, are recited in the listings of ingredients in examples 32 to 36 on page 17 of the originally filed specification. The "lanolin alkoxylates" are recited as the second ingredient in each of the two tables on page 17 and thus are clearly lanolin derivatives described in the originally filed specification. The percentage for the lanolin alkoxylates (2 % in the tables on page 17) is also clearly within the 0.1 and 5 wt. % required by claim 42.

The following arguments, which were also summarized in the advisory action, are repeated here for convenience. No other problems with the following reasoning were pointed out in the advisory action so that it is believed to be sound and convincing and thus the objection and rejection should be withdrawn.

The term "hair-care agent" would be considered by one skilled in the art to be synonymous with the term "hair-care constituents". Both would be considered to mean an ingredient or chemical compound with hair-care properties.

The examples of the hair-care constituents given in the second full paragraph on page 7 include cationic resins, lanolin derivatives and cholesterol. However these are categories of hair-care constituents, except in the case of cholesterol. Thus because of the term "each" in line 7 of the third full paragraph on page 7 of applicants' specification, **each** of the hair-care ingredients (constituents) in the category of cationic resins or lanolin derivatives that is present in the composition may be present in the composition in an amount of 0.1 to 5 wt. %.

However the term "derivatives" in composition claims often leads to their rejection as indefinite. Hence the term "lanolin derivatives" has been replaced by "lanolin, lanolin alcohols, lanolin alkoxylates". Examples 32 and 34 provide the basis for limiting the term "lanolin derivatives" to "lanolin, lanolin alcohols, and alkoxylates". In addition, note that the term "wool grease", which is a respective ingredient of examples 48 and 49, is an alternative term for "lanolin" according to Wikipedia Encyclopedia on the Internet.

A generic description of an ingredient in a composition claim may be limited to a specific ingredient or ingredients that fall within the generic description, as long as the specification discloses the

specific ingredients at some point. Thus it should be acceptable to replace “lanolin derivatives” by specific examples disclosed in the applicants’ specification. Also because of the term “each” one skilled in the art would understand that each hair-care ingredient can be present in an amount of 0.1 to 5 wt. %.

According M.P.E.P. 2163.05 II the criteria for adequate support of claim changes that narrow a generic composition claim is whether or not the specification discloses the species or not. The applicants’ specification teaches that the auxiliary ingredients may include lanolin derivatives. The generic claim 42 recites specific lanolin derivatives among the other auxiliary ingredients, which are disclosed in the specification, e.g. lanolin alcohol, but these specifically recited lanolin derivatives are disclosed in the examples at the end of applicants’ specification. One skilled in the art does not need an explicit statement in specification that lanolin alcohol is a lanolin derivative, because that is common knowledge in the cosmetic arts. Thus the recitation of lanolin alcohols and lanolin alkoxylates in claim 42 should not be considered to violate the written description requirement.

Claims 47 to 50

Claim 47 has been amended as required on page 4 of the advisory action to change “at least 1 %” to “1%”. Hence claims 47 and 48 would now be fully supported by the disclosures in example 1 on pages 10 and 11 of applicants’ originally filed specification, provided the proposed change in claim 47 is made (see page 21 of the amendment filed in February 2011).

The proposed changes in claim 49 suggested in the amendment after final action filed in June of 2011 were not entered. After careful consideration of the basis for claim 49 in the originally filed specification applicants have decided to cancel claim 49 to facilitate further prosecution and allowance of the above identified U.S. Patent Application without replacement with any other suggested new claim.

Claim 51 has been canceled and appropriate subject matter supported by the originally filed specification has been included from claim 51 in claim 50.

According to the advisory the proposed change in claim 50, which stated that the composition of the shampoo recited in the claim included 10 wt. % of sodium lauryl ether sulfate was incorrect and should have read 40 wt. % of sodium lauryl ether sulfate. It is respectfully submitted that this proposed change in the advisory action is incorrect because the shampoo according to example 6 disclosed on page 14 of the applicants' originally filed specification includes "40.0 wt. % of sodium lauryl ether sulfate (**25%**)". The 25 % in parenthesis following "sodium lauryl ether sulfate" means that the ingredient which is present in the amount of 40.0 wt. % would be understood by one of ordinary skill in the art to be a 25 % solution of sodium lauryl ether sulfate (In any case it would not be sodium lauryl ether sulfate itself).

The aforesaid proposed change in claim 50 should not be considered "new matter", because the proposed change merely amounts to rephrasing of the written description of the example 6 on page 14 of the applicants' specification regarding the amount of sodium lauryl ether sulfate (25 %) present in the shampoo of example 6 and hence should be considered acceptable and not new matter (see M.P.E.P. § 2163.07). One skilled in the art would understand that the ingredient that is present in a 40.0 wt. % amount is a 25 % solution of sodium lauryl ether sulfate, not merely

sodium lauryl ether sulfate itself, because the (25 %) implies that it is a solution in which that anionic surfactant is present in the amount of 25 %.

Claims 47, 48, and 50 have been amended to overcome their rejection under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement in the final Office Action. The changes suggested on page 3 of the final Office Action have been made to overcome this formal rejection in claims 48 and 50.

For the aforesaid reasons and because of the proposed changes in claims 42, 47, 48, and 50, entry of the changes in claims 42, 47, 48, and 50 and withdrawal of the rejection of claims 33 to 36, 38, and 41 to 48 and 50 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, are respectfully requested.

III. Withdrawn Claims

Withdrawn claim 19 has been amended to make the same changes in the recitation of the auxiliary agent that were made in claim 42.

The primary distinguishing features in method claim 42 reside in the composition with the active ingredient recited in step a. Main agent claim 19 is a composition claim with the same limitations as in step a of claim 42. Hence claim 19 contains the same distinguishing limitations as claim 42 and should also be considered to be free of the prior art.

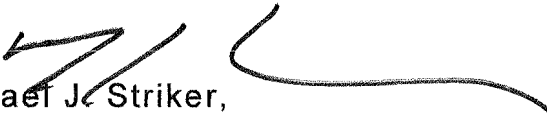
For the aforesaid reasons agent claims 19 and 23 to 29 should be rejoined and allowed under the doctrine of rejoinder M.P.E.P. § 821.04, since the above-identified U.S. patent application is the national stage of PCT/EP 2005/001442. Since this is a U.S. National stage application of a corresponding PCT International Application, unity-of-invention practice applies. Both amended claims 19 and 42 contain the same common technical factors that distinguish their subject matter from the prior art of record. Thus in accordance with PCT Rule 13.1 and 13.2 claims 19 and 23 to 29 should be rejoined and allowed.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to

issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,


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